

Response under 37 C.F.R. 1.116
- Expedited Examining Procedure -
Examining Group 1774

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Customer No. 01333

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Inventor(s):

Thomas M. Laney, et al.

INKJET RECORDING ELEMENT
AND METHOD OF USE

Group Art Unit: 1774

Examiner: Pamela R. Schwartz

Serial No.: 10/722,886

Filed: November 26, 2003

Commissioner for Patents
Alexandria, VA 22313-1450

RESPONSE UNDER 37 C.F.R. 1.116

Sir:

Claims 1 and 3-42 are pending in the application. Claims 16-20 and 36-38 have been withdrawn from consideration. Claims 1, 3-15, 21, and 39-42 have been finally rejected. Favorable reconsideration of the application in view of the following remarks is respectfully requested.

Relying on 35 U.S.C. 102(b), the Examiner rejected claims 1, 3-15, and 39-42 as being anticipated by Morita et al.. The Examiner states, "It would have been obvious to one of ordinary skill in the art to modify the composition to prevent the unfavorable breakage suggested by the reference."

Applicants' position is that only hindsight is necessary for such an unsupported allegation, as clearly detailed in Applicants' Amendment of 18 May 2007.

Applicants therefore respectfully request that the Examiner reconsider and withdraw the rejection of the claims under 35 U.S.C. 102(b).

Claims 1, 3-15, 21, and 39-42 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Morita et al. It is the conclusion of the

Examiner that “modifications would have been obvious to one of ordinary skill in the art to achieve either of the results set forth above.”

Again, Applicants position is that the Examiner’s rejection is clearly based on hindsight, providing no evidentiary or factual support other than Applicants’ own teachings, as clearly detailed in Applicants Amendment of 18 May 2007. Morita et al. cannot possibly teach an inkjet recording element comprising a permeable microvoided layer of polylactic-acid-based material characterized by interconnecting voids enabling capillary action, for an ink adsorption rate resulting in a dry time of less than 10 seconds, the microvoids occupying from 40 to 65 percent by volume of the microvoided layer. This is for the simple reasons that Morita et al. is directed to obtaining materials such as sanitary diapers and does not intend to obtain an inkjet recording element and does not teach how to obtain it.

In view thereof, it follows that the subject matter of the claims would not have been obvious of Morita et al. at the time the invention was made.

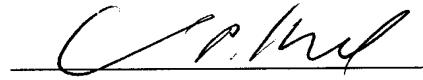
The Examiner states that the term inkjet recording element lends little if any structure to the medium. Applicants submit as a matter of common sense it lends sufficient structure to make clear that the cited prior art is not making an inkjet recording element or remotely teaching one. The claimed properties of the inkjet recording element confirm that distinguishing structure. Again, the Examiner improperly applies “inherency” to obviousness, a clear error of law. The Examiner concedes that Morita et al. provides no example or particular product that remotely teaches the present invention. Therefore, the Examiner cannot point to anything specific other than general unsupported allegations. The Examiner is clearly wrong in alleging that the prior art states, intends, or implies anything with respect to an inkjet recording element, and the present application is, therefore, ripe for appeal unless the Examiner reconsiders the issues in a more objective light.

Applicants have reviewed the prior art made of record and believe that singly or in any suitable combination, they do not render Applicants’ claimed invention unpatentable.

In view of the foregoing remarks and amendment, the claims are now deemed allowable and such favorable action is courteously solicited.

Should the Examiner consider that additional amendments are necessary to place the application in condition for allowance, the favor is requested of a telephone call to the undersigned counsel for the purpose of discussing such amendments.

Respectfully submitted,



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